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7
8 UNITED STATES DISTRICT COURT
9 CENTRAL DISTRICT OF CALIFORNIA

10 DC Comics,

11 Plaintiff,

12 v.

13 Mark Towle, an individual and d/b/a
14 Gotham Garage, and Does 1-10,
15 inclusive,

16 Defendants.

Case No. CV11-3934 RSWL (OPx)

**PLAINTIFF'S OPPOSITION TO
DEFENDANT'S MOTION FOR
PARTIAL SUMMARY
JUDGMENT**

DATE: January 30, 2013
TIME: 10:00 am
COURTROOM: 21

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19 3 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 12.06, at 12-126
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INTRODUCTION

This case is not about the car industry: it is about Defendant Mark Towle's ("Defendant") unlawful and slavish copying of Plaintiff DC Comics' ("DC Comics") **Batmobile**. There is no dispute that Defendant's lucrative and illegitimate business is built almost entirely on the goodwill and artistry owned exclusively by DC Comics. In an attempt to distract the Court from his obvious wrongs, Defendant moves for summary judgment based upon faulty legal arguments and overheated rhetoric.

It is undisputed that DC Comics (through its predecessor) introduced Batman and the Batmobile to the world. Through DC Comics' careful shepherding of the Batman characters and stories and its significant investment of talent and resources over many decades, the Batman universe, including the Batmobile, has reached iconic status in popular culture. Defendant's erroneous motion cannot hide this simple fact: Defendant's business is intended to copy and profit from DC Comics' extensive goodwill in the Batman franchise and its world famous Batmobile. Defendant's Motion for Partial Summary Judgment ("Motion") and should be denied.

Recognizing the lack of merit in his defenses, Defendant is left to resort to baseless procedural arguments. But these arguments not only fail on their merits, they fail to establish any possible prejudice to Defendant. Finally, and notably, Defendant's Motion does not dispute the facts in support of DC Comics' cross-motion for summary adjudication and ignores issues of law already decided by this Court.¹

STATEMENT OF FACTS

Defendant does not dispute DC Comics' standing, its longstanding ownership of the underlying rights, or the copyright and/or trademark protections which have been extended to those intellectual properties as outlined in support of DC Comics' own cross-motion for summary judgment. Passim DC Comics' Separate Statement of

¹ To the extent that the Defendant attempts to re-litigate the applicable legal standards in his Motion which have already been decided by the Court's Order Denying Defendant's Motion to Dismiss, Dkt. No. 22, these matters are law of the case and further litigation of these issues is precluded. Jeffries v. Wood, 114 F.3d 1484, 1489 (9th Cir. 1997); Segal v. American Tel. & Tel. Co., 606 F.2d 842, 845 (9th Cir. 1979).

1 Uncontroverted Facts and Conclusions of Law on DC Comics' Motion for Summary
 2 Judgment ("SS"), Dkt. No. 43, ¶¶ 1-8.²

3 Defendant concedes that the BATMOBILE is famous. DC Comics' Statement
 4 of Genuine Disputes at Supplemental Uncontroverted Facts ("SUF") at ¶ 1. The
 5 BATMOBILE was originally introduced in the 1940s and has undergone many
 6 transformations over the years, including various versions in design and style
 7 ("Batmobile Vehicles"). *Id.* at ¶ 2. DC Comics, in its own right or as successor-in-
 8 interest, has at all times been and still is the sole proprietor or otherwise authorized to
 9 enforce all right, title and interest in and to the copyrights and trademarks of the
 10 various BATMAN characters and associated elements, Batmobile Vehicles, and all
 11 comic books in which any of the foregoing have appeared. SS at ¶¶ 11-12.

12 In 1965, DC Comics contracted with American Broadcasting Company
 13 ("ABC") to license its BATMAN character and associated elements for use in a
 14 television series. SS at ¶ 13. DC Comics reserved all rights in and to the characters
 15 and elements depicted in the television series to be produced. *Id.* at ¶ 14; SUF at ¶ 4.
 16 ABC then contracted with Greenway Productions, Inc. ("Greenway") and Twentieth
 17 Century-Fox Television, Inc. ("Fox") to produce the television series. SS at ¶ 15.
 18 Greenway and Fox have duly registered all episodes of the *Batman* television series
 19 with the U.S. Copyright Office. *Id.* at ¶ 16. The Court, at Defendant's insistence,
 20 took judicial notice of the various copyright registrations, including the registration for
 21 the premiere episode of the *Batman* television series entitled "Hi, Diddle Riddle,"
 22 SUF at ¶ 13, which Defendant now seeks to exclude.

23 One of the BATMAN-associated elements licensed to Greenway and Fox was a
 24 depiction of the Batmobile Vehicles to be featured in the 1966 television program

25
 26 ² For ease of reference, DC Comics respectfully requests that the court take judicial notice of the
 27 Separate Statement of Uncontroverted Facts and Conclusions of Law on Plaintiff's Motion For
 28 Summary Judgment and the underlying evidence already part of the record and filed on December
 26, 2012, as Dkt. Nos. 42-56, as well as the documents filed under seal including Exhibits A, B, and
 G to the Declarations in Support of Plaintiff's Motion for Summary Judgment, and Exhibits 8-13 and
 15-22 to the Joint Stipulation re Motion for Summary Judgment.

1 (“the 1966 Batmobile”). SS at ¶ 17. The 1966 Batmobile is a derivative work of the
 2 Batmobiles depicted in the comics. *Id.* at ¶ 18; SUF at ¶ 5. Barris Kustom City
 3 (“Barris”) manufactured the 1966 Batmobile and retained title to the original vehicle.
 4 SS at ¶ 19; DC Comics’ Statement of Genuine Disputes at Genuine Disputes (“GD”)
 5 at ¶¶ 11, 14-15. All copyright and trademark rights to the 1966 Batmobile, however,
 6 were retained by DC Comics. SS at ¶ 20; SUF at ¶ 4; GD at ¶ 15. This fact (omitted
 7 by Defendant) was reaffirmed in a 1966 agreement between DC Comics, Fox,
 8 Greenway, and Barris. *Id.* at ¶ 20; SUF at ¶ 9; GD at ¶ 16. In addition, as expressly
 9 outlined in its agreement with ABC, DC Comics was granted the *exclusive*
 10 merchandising rights to the BATMAN-related elements featured in the 1966
 11 television program, including the 1966 Batmobile. SS at ¶ 24.

12 In 1989, pursuant to license from DC Comics, Warner Bros. Inc. (“Warner
 13 Bros.”) produced the first of several BATMAN films entitled *Batman*. SS at ¶¶ 25-27.
 14 Warner Bros. has duly registered the film with the U.S. Copyright Office. *Id.* at ¶ 28;
 15 GD at ¶ 38. The Court, at Defendant’s insistence, took judicial notice of various
 16 copyright registrations, including the registration for the 1989 *Batman* motion picture,
 17 SUF at ¶ 13, which Defendant now seeks to exclude. This registration states
 18 explicitly that it is a derivative work of the “BATMAN comic book series” among
 19 other things. SS at ¶ 30; Joint Stipulation re Motion for Summary Judgment (“Joint
 20 Stip.”) at Ex. 4.

21 DC Comics’ license included a depiction of the Batmobile Vehicles to be
 22 featured in the 1989 motion picture (“the 1989 Batmobile”). SS at ¶ 29; GD at ¶ 37.
 23 Like the 1966 Batmobile, the 1989 Batmobile was a derivative work of the Batmobile
 24 Vehicles that appeared in the comics. SS at ¶ 30. All copyright and trademark rights
 25 to the 1989 Batmobile were retained by DC Comics. *Id.* at ¶ 32; SUF at ¶¶ 4, 8-9; GD
 26 at ¶¶ 37, 39. Exclusive merchandising rights for all elements contained in the 1989
 27 *Batman* film, including any new characters or elements, specifically including the
 28 1989 Batmobile, were retained by DC Comics. SS at ¶ 34.

Defendant operates Gotham Garage, which specializes in the manufacture of replicas of automobiles featured in various motion pictures or television programs. SS at ¶ 44. Among the vehicles Defendant has reproduced and distributed are replicas of the 1966 Batmobile and the 1989 Batmobile. *Id.* at ¶¶ 45, 47-48, 50; SUF at ¶ 10. Defendant has also manufactured and distributed car kits that allow others to customize their vehicles into the 1966 Batmobile and the 1989 Batmobile. SS at ¶¶ 46-47, 49-50. In addition, Defendant has manufactured and distributed various automobile parts and accessories featuring the DC Comics Trademarks.³ *Id.* at ¶ 51. Defendant's advertisements and offers for sale prominently use DC Comics' copyrights and trademarks to promote Defendant's business. *Id.* at ¶ 52-53; SUF at ¶ 10. Defendant admits his knowledge of the BATMAN property, including the 1966 television series *Batman*, the 1989 film *Batman*, the 1966 Batmobile, the 1989 Batmobile, and the various BAT emblems and symbols used in connection therewith. SS at ¶ 54; SUF at ¶¶ 11-12; see also Declaration of Mark Towle in Support of MSJ ("Towle Decl.") at ¶ 8 (public identifies Batmobiles and his replicas as the one "used on the TV show" and "the one that appeared on screen in the movie.").

Defendant is not authorized by DC Comics to manufacture, sell, offer for sale, distribute or otherwise reproduce any products bearing DC Comics' copyrights or trademarks. SS at ¶ 55; GD at ¶ 86. All of the products manufactured or sold by Defendant are unauthorized. SS at ¶ 56; GD at ¶ 86.

ARGUMENT

I. Summary Judgment Standard.

Summary judgment is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). "Summary judgment in favor of

³ See Towle Depo. at pp. 25:22-26:21 (sticker/decal); 109: 5-11 (bat phone for hands free cellular usage); compare Reg. No. 2,199,266 (decals); Reg. No. 3,299,017 (cellular telephone accessories); Reg. No. 3,110,604 (decals), to name a few.

the party with the burden of persuasion . . . is inappropriate when the evidence is susceptible of different interpretations or inferences by the trier of fact.” Hunt v. Cromartie, 526 U.S. 541, 553 (1999). If the evidence is such that a reasonable jury could return a verdict for the nonmoving party, summary judgment is not proper. First National Bank of Arizona v. Cities Service Co., 391 U.S. 253 (1968). If reasonable minds could differ as to the import of the evidence, summary judgment is not proper. Wilkerson v. McCarthy, 336 U.S. 53, 62 (1949). The judge’s function at the summary judgment stage is not to weigh the evidence and determine the truth of the matter but only to determine whether there is a genuine issue for trial. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986).

“When the moving party also bears the burden of persuasion at trial, to prevail on summary judgment it must show that ‘the evidence is so powerful that no reasonable jury would be free to disbelieve it.’” Shakur v. Schriro, 514 F.3d 878, 890 (9th Cir. 2008). Any inferences drawn from the underlying facts must be viewed in the light most favorable to the party opposing the motion. Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986). Based on the applicable standards, Defendant’s Motion should be denied.

II. It Is Undisputed that DC Comics Owns Valid Copyright Rights to the Batmobile Vehicles.

Copyright infringement is established by showing (1) ownership of a valid copyright interest, and (2) violation of that copyright interest by the defendant. 17 U.S.C. § 501(a); Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1159 (9th Cir. 2006); A & M Records v. Napster, Inc., 239 F.3d 1004, 1013 (9th Cir. 2001). While Defendant concedes that second element – that he manufactures and distributes “replicas” of two versions of the Batmobile Vehicles – he contests the first element, asserting that DC Comics owns no copyright interest in the Batmobile Vehicles.

As demonstrated herein, DC Comics owns valid and enforceable copyright interests in the 1966 and 1989 Batmobiles that appeared in the television series and

1 feature film. DC Comics expressly reserved all copyright interests in its agreements
2 with the producers of the 1966 *Batman* television series and the 1989 *Batman* film.
3 Moreover, the Batmobiles depicted in these works were derivatives of Batmobiles that
4 had been depicted in DC Comics' copyrighted comic books. In addition, DC Comics
5 was also granted exclusive merchandising rights to all Batman-related elements
6 appearing in the 1966 television series and 1989 motions picture, specifically
7 including the Batmobile Vehicles. Accordingly, DC Comics is vested with the right
8 to enforce the copyrightable elements of the Batmobile Vehicles, including the overall
9 "look and feel" as well as any separable, artistic features of what Defendant purports
10 to be "useful articles."

11 In view of this overwhelming showing, it is no surprise that Defendant now
12 resorts to technical procedural arguments to avoid the consequences of his
13 infringement. Specifically, Defendant argues that the Court should not consider
14 certain copyright registrations not specifically listed in Exhibit A to the First
15 Amended Complaint. Defendant makes this argument even though it is conceded that
16 he has been aware that DC Comics has asserted copyright interests in these
17 registrations since the beginning of the case. Indeed, Defendant himself requested that
18 the Court grant judicial notice of the copyright registrations of the premiere episode
19 from the 1966 television series ("Hey Diddle Riddle") and the 1989 motion picture in
20 moving to dismiss DC Comics' complaint at the beginning of the case. *SUF* at ¶ 13.
21 The fact that Defendant has been on notice of these registrations, which were timely
22 disclosed and at all times equally available to Defendant as matters of public record,
23 cannot be denied.⁴

24
25
26 ⁴ Even were the Court to consider only the works identified in the registrations in the name of DC
27 Comics, there are sufficient original and protected elements in the underlying comics and
28 publications, including both specific separate, expressive and non-functional elements and overall
look and appearance, to deny Defendant's Motion. But there is no reason whatsoever to exclude the
1966 television series registrations, particularly where the court has already taken judicial notice of
the registration of the key premiere episode that prominently features the Batmobile.

A. DC Comics Owns all Intellectual Property to the Batmobile Vehicles.

Defendant does not dispute DC Comics' ownership of the underlying BATMAN property and the comic books in which the Batmobile Vehicles have appeared. Further, Defendant ignores the fact that the relevant agreements concerning the 1966 Batmobile and the 1989 Batmobile all set forth unequivocally that DC Comics owns all copyrightable elements to the Batmobile Vehicles, whether pre-existing or added to the derivative works. In fact, even the evidence on which Defendant attempts to rely only further proves DC Comics' rights in the Batmobile Vehicles. Barris, in his 1966 agreement (SUF at ¶ 9) and through his payment of licensing royalties to DC Comics (SUF at ¶ 7), and Furst, through his work-for-hire agreement (GD at ¶ 37) and assignment of a design patent (GD at ¶ 8) to DC Comics, both acknowledge and confirm that DC Comics is the owner of all copyright interest to the Batmobile Vehicles. Defendant has no explanation for Barris' and Furst' express recognition of DC Comics' Batmobile rights.

The fact that parties other than DC Comics own copyright interests in works depicting the Batmobile, such as the 1966 *Batman* television series, is plainly irrelevant. Copyright rights are a "bundle of exclusive rights" each of which can be licensed, assigned, reserved, or otherwise transferred. Stewart v. Abend, 495 U.S. 207, 220 (1990); see also Halicki Films LLC v. Sanderson Sales & Mktg., 547 F.3d 1213, 1220 (9th Cir. 2008) ("owners and exclusive licensees of copyright may enforce a copyright or license"). Thus, the fact that Fox is the registered owner of the 1966 *Batman* television series episodes is meaningless, particularly where, as here, DC Comics expressly reserved all rights in the *Batman* elements in that series.

The fact that a party can own a copyright interest in a work registered by another is not, as Defendant would have the Court believe, controversial. Indeed, a court has already found that DC Comics is the owner of the copyrights in and to the characters and elements represented in the 1966 *Batman* television series, despite not being copyright registrant. See White v. Samsung Elec. Am., Inc., 989 F.2d 1512,

1 1518 (9th Cir. 1993) citing Carlos V. Lozano, *West Loses Lawsuit over Batman TV*
 2 *Commercial*, L.A. Times, Jan. 18, 1990, at B3 (describing Adam West's right of
 3 publicity lawsuit over a commercial produced under license from DC Comics, owner
 4 of the Batman copyright).⁵ Based on such rights, DC Comics has licensed third-
 5 parties to make Batmobile replicas in both toy and full-size form since 1966. SS at ¶
 6 39; SUF at ¶ 20. In sum, there is no dispute that DC Comics is the exclusive owner of
 7 all rights related to the Batmobile, SS at ¶¶ 24, 29, 32, 34; SUF at ¶ 4, and that
 8 Defendant has infringed on such rights.

9 **B. The Batmobile Vehicles, and the Original Expressive Elements**
 10 **Contained Therein, Are Copyrightable.**

11 This Court has already ruled that there is an exception to the “useful article”
 12 rule, “which grants copyright protection to non-functional, artistic elements of an
 13 automobile design that can be physically or conceptually separated from the
 14 automobile.” Dkt. No. 22 at 4:27-5:4. As a matter of law, the “Batmobile and all of
 15 its relevant embodiments are not...excluded from copyright protection.” Id. at 5:12-
 16 14. Defendant's protests otherwise are contrary to law and properly rejected.⁶

17 Defendant's remaining argument is that the copyrightable elements identified
 18 by DC Comics were not infringed because they either a) do not appear in any comic
 19 books, b) are “not separable,” c) are “functional,” d) are not “artistic,” e) were not
 20 found on Defendant's “replicas,” or f) are parts normally found on a car. Motion, p.
 21 16, Exs. 33 & 34. Once again, Defendant misses the point.⁷ The fanciful elements
 22 identified by DC Comics were designed and intended to aid just one crime-fighting

23 ⁵ Full text available at: http://articles.latimes.com/1990-01-18/local/me-291_1_adam-west (last
 24 visited January 3, 2012). For the Court's convenience, a copy of the judicially-referenced article is
 attached hereto as Exhibit A.

25 ⁶ See footnote 1 re law of the case authority. Moreover, Defendant's reliance on Leicester v. Warner
 26 Bros., is misplaced as that case not only does not concern the Batmobile Vehicles, it does not even
 concern cars, instead dealing with architectural details that are the subject of specific legislative
 language not at issue here, specifically 17 USC § 120. 232 F.3d 1212 (9th Cir. 2000).

27 ⁷ Defendant also misses the point in his continued touting of preclusion of copyright protection for
 28 the 1966 Batmobile and the 1989 Batmobile based on the existence of design patents. The Supreme
 Court has specifically noted that “[n]either the Copyright Statute nor any other says that because a
 thing is patentable it may not be copyrighted.” Mazer v. Stein, 347 U.S. 201, 217 (1954).

1 vigilante, with specific “Bat” characteristics, and are what make the “Batmobile”
 2 distinguishable from just a car, or any car for that matter.⁸

3 Defendant’s assertion that certain copyrightable elements did not initially
 4 appear in comic books is irrelevant. The rights to the copyrighted Bat Emblem are
 5 uncontradicted. The rights to the Batmobile Vehicles, aside from being derivative
 6 works based on the original series created by DC Comics, also flow from rights
 7 reserved exclusively by DC Comics to the *Batman* television series and *Batman*
 8 movie, among others. SS at ¶¶ 20-24, 29-30, 32, 34; GD at ¶¶ 2, 4. Mr. Barris, who
 9 built the original 1966 Batmobile for the television show testified that he created a
 10 “Batmobile that was reflected to the script...to be Batman and Robin, and a car that
 11 they could use.” SUF at ¶ 5. These characters clearly predated the television show as
 12 their personas originated with DC Comics in the late 1930s. SUF at ¶ 2. The 1966
 13 Batmobile was specifically tailored for the characters and the fictional BATMAN
 14 world created by DC Comics.

15 Defendant’s statements that the original elements identified by DC Comics are
 16 “not separable,” are “functional,” are not “artistic,” or are parts normally found on a
 17 car, are supported largely only by conclusory statements from Defendant’s self-
 18 serving declaration which contradicts his deposition testimony in certain respects. See
 19 GD at ¶¶ 62-71, 76-79. For example, Defendant misleads in his declaration in
 20 claiming there is no Bat-Ray on his car, when there is clearly a “Bat-Ray” label on the
 21 dashboard of his replica. See GD at ¶ 61. Defendant’s attempt to rely on the
 22 deposition of Mr. Barris similarly fails in light of his limited role in building a prop
 23 according to specifications of the producers and to which DC Comics retained all
 24 applicable copyrights. See SUF at ¶¶ 4-5; GD at ¶¶ 11-16, 20-35. Indeed, Mr. Barris
 25 conceded that he retained no rights in the Batmobile as evidenced by his entering into

26 ⁸ As set forth in the Statement of Genuine Disputes, Defendant admits that numerous fanciful
 27 elements identified by Plaintiff were included in his replicas, contrary to his declaration otherwise,
 28 including the labeled and completely non-functional and ornamental “Bat-Ray,” and other “faux” or
 “decorative” elements. See, e.g., Towle Depo. at 101:8-21, 102:2-104:3, 107:8-108:16, 109:5-11.
 These admissions separately preclude summary judgment in Defendant’s favor.

1 a royalty-bearing license with DC Comics in order to exhibit the Batmobile from the
2 series. SUF at ¶ 7.

3 Moreover, Defendant also misapplies the “useful article” test, confusing
4 separability with literal physical detachment. The accurate test is whether the
5 “pictorial, graphic, or sculptural features” can be “identified separately from, and are
6 capable of existing independently of, the utilitarian aspects of the article.” 17 U.S.C.
7 § 101. Defendant’s numerous “Bat” gadgetry, most of which are non-functional and
8 some of which are in the shape of the Bat Emblem trademark (which appeared as
9 early as 1944 in DC Comics’ copyrighted comics), have no function relating to the
10 operation of a car and are artistic elements stolen from DC Comics’ Batmobile
11 Vehicles in order to trade upon the popularity of the BATMAN franchise. It is this
12 distinction that makes the elements copyrightable and Defendant’s use infringing.

13 As a fallback, Defendant argues that some original elements were not found on
14 his replicas. Even if true, it is irrelevant where the test of infringement is substantial,
15 as opposed to identical, copying. Declining to engage in the same invitation to dissect
16 the works, the Ninth Circuit stated “it is the *combination* of many different elements
17 which may command copyright protection because of its particular subjective
18 quality.” Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp., 562 F.2d
19 1157, 1169 (9th Cir. 1977). The Ninth Circuit also “require[s] a lower standard of
20 proof of substantial similarity when a high degree of access is shown.” Three Boys
21 Music Corp. v. Bolton, 212 F.3d 477, 485 (9th Cir 2000). “Similarity of expression
22 focuses on the response of the ordinary reasonable person, and considers the total
23 concept and feel of the works.” Micro Star v. Formgen Inc., 154 F.3d 1107, 1112 (9th
24 Cir. 1998). “[S]light differences between a protected work and an accused work will
25 not preclude a finding of infringement.” Durham Inds., Inc. v. Tomy Corp., 630 F.2d
26 905, 913 (2d Cir. 1980) citing Concord Fabrics, Inc. v. Marcus Brothers Textile Corp.,
27 409 F.2d 1315, 1316 (2d Cir. 1969) (minor differences emphasize extent of deliberate
28 copying). Defendant has unquestionably copied the overall look and feel of the

1 Batmobile Vehicles, deliberately intending his replicas to appear as close to identical
2 as possible to DC Comics' Batmobile Vehicles.

3 The overall "look and feel" of the Batmobile Vehicles is protected under
4 copyright and the copying of which, infringement. See Atari, Inc. v. North Am.
5 Philips Consumer Elecs. Corp., 652 F.2d 607, 619-20 (7th Cir. 1982); Sturdza v. Gov't
6 of the United Arab Emirates, 281 F.3d 1287, 1296 (D.D.C. 2002) citing Boisson v.
7 Banian, Ltd., 273 F.3d 262, 272 (2d Cir. 2001); Identity Arts v. Best Buy Enter. Serv.,
8 Inc., Case No. C 05-4656 PJH, 2007 U.S. Dist. LEXIS 32060, at *72 (N.D. Cal. Apr.
9 18, 2007). Even the "look and feel" of functional articles can be afforded copyright
10 protection as "protectable expression may arise through the ways in which artists
11 combine even unprotectible elements." Sturdza, 281 F.3d at 1296 citing Boisson, 273
12 F.3d at 272. Thus, Defendant's attempt to isolate and focus on a few specific
13 elements that do not appear in his replicas does nothing to detract from the fact those
14 "replicas" by their very nature copied the "look and feel" of the real thing.⁹

15 Additionally, the Ninth Circuit has already ruled that cars depicted in movies
16 can be copyrightable. Halicki Films, 547 F.3d at 1224-25. In Halicki Films, the
17 defendants built full-size working replicas of the Eleanor automobile, a vehicle
18 modified to resemble a 1967 Shelby GT-500, featured in the 2000 film *Gone In 60*
19 *Seconds*. Id. at 1218. The Ninth Circuit remanded the case to determine whether
20 Eleanor was entitled to copyright protection as a character. Id. at 1225. The Ninth
21 Circuit noted that Eleanor, referred to by name, "display[s] consistent, widely
22 identifiable traits" and is "especially distinctive." Id. Upon remand, the district court
23 ruled a "reasonable jury could find that 'Eleanor' is an 'especially distinct' character
24 ... such that copyright protection is merited" (internal citation omitted). Halicki v.
25 Carroll Shelby International, Case No. 04-8813 SJO (PJWx), Order Regarding Issues

26 ⁹ The ornamental Bat-features on the 1966 Batmobile replicas which are heavily emblazoned with
27 the Bat Emblem associated trademarks and the exaggerated "bat" characteristics in the fins as well
28 as the faux jet engine of the 1989 Batmobile replicas were made with the express purpose to
"mimic" the television and movie, authentic counterparts, as admitted by Defendant and consistent
with the definition of a "replica." SUF at ¶¶ 10-12 14; GD at ¶¶ 61-72, 76-79; SS at ¶¶ 45-50.

1 Remanded from the Ninth Circuit, Docket No. 330, filed August 12, 2009 (“Halicki
2 Remand”) at p. 15.¹⁰

3 The Batmobile Vehicles are even more distinctive and widely identifiable than
4 Eleanor. These are not merely vehicles with customized paint and trimmings; they are
5 interactive, highly advanced automobiles equipped with futuristic gadgetry and
6 aesthetics uncommon to vehicles of their time.¹¹ The Batmobile Vehicles are not
7 referred to simply as “cars” but rather by name – BATMOBILE. They interact with
8 the BATMAN and ROBIN characters and serve as integral parts of the stories being
9 told by the respective comic books, television programs and motion pictures in which
10 they appear. Thus, the Batmobile Vehicles are entitled to copyright protection.

11 The Batmobile Vehicles at issue herein demonstrate far more original,
12 expressive and copyrightable content than is true in other cases where copyright
13 protection has attached. See, e.g., Sunset House Dist. Corp. v. Doran, 304 F.2d 251,
14 252 (9th Cir. 1962) (plastic Santas); Hart v. Dan Chase Taxidermy Supply Co., 86 F.3d
15 320, 323 (2d Cir. 1996) (fish mannequins which were “designed to be looked at”);
16 Edwin K. Williams & Co. v. Edwin K. Williams & Co.-East, 542 F.2d 1053, 1061 (9th
17 Cir. 1976) (blank forms with instructions); Kieselstein-Cord v. Accessories by Pearl,
18 Inc., 632 F.2d 989, 993 (2d Cir. 1980) (belt buckle). There is no doubt that the
19 Batmobile Vehicles are sufficiently original to be protected by copyright.

20 As the Batmobile Vehicles and their original elements are copyrightable,
21 Defendant’s admission of the origin of his replicas of the Batmobile Vehicles through
22 DC Comics’ television and motion picture works creates a presumption of copying
23 shifting the burden to Defendant rebut or to show that the alleged infringing work was
24 independently created. SUF at ¶¶ 10-12 14; GD at ¶¶ 61-72, 76-79; SS at ¶¶ 45-50;
25 Three Boys Music Corp., 212 F.3d at 485. Defendant is unable to meet his burden as

26 ¹⁰ For the Court’s convenience, a copy is attached hereto as Exhibit B and for which DC Comics
27 requests judicial notice.

28 ¹¹ A number of these features are listed in the section re the separable, copyrightable element, *infra*. While some of these features, such as the mobile phone of the 1966 Batmobile, may be more commonplace now, at the time, they were regarded as innovative sci-fi elements.

he admits making “replicas” of the protected Batmobile Vehicles, satisfying this element of DC Comics’ claim for copyright infringement. Judgment for DC Comics is appropriate on its claim for copyright infringement.

C. Defendant’s Attempt to Preclude Evidence Supporting DC Comics’ Ownership Rights in the Batmobile Vehicles Should Be Rejected.

From the beginning of this case, DC Comics has put Defendant on notice that he has infringed DC Comics’ copyright rights in the Batmobile Vehicles as they have appeared in various comic books, publications, television series and motion pictures, including the 1966 television series *Batman* and the 1989 motion picture *Batman*. SUF at ¶ 15; GD at ¶ 1. Defendant was clearly aware of this, seeking and being granted judicial notice approximately one year ago on these very registrations. SUF at ¶¶ 13, 16. Nonetheless, Defendant argues that the Court should not consider these registrations, feigning ignorance of DC Comics’ reliance on them and complaining that certain of the physical certificates were not produced until the end of discovery.¹² Defendants’ arguments fail for multiple reasons.

First, Defendant was clearly on notice and aware of the copyrights *from the outset*. As detailed above, at the beginning of this case Defendant requested judicial notice of the copyright registrations of the premiere episode of the 1966 series and the 1989 motion picture, and attached printouts of the registration information from the U.S. Copyright Office website. SUF at ¶ 13.

¹² On April 12, 2012, DC Comics identified in its initial disclosures “copies of trademark and copyright registration certificates,” the specificity of which was never challenged by Defendant. GD at ¶ 45. On October 23, 2012, DC Comics supplemented its disclosures to specify the third-party registrations on which it would be relying. *Id.* During the course of discovery, DC Comics produced more than 3,500 pages of documents within its possession, custody and control, including numerous agreements relating to the 1966 television series and 1989 motion picture, in response to Defendant’s discovery requests. *Id.* at ¶¶ 45, 47. DC Comics’ witness also testified, on September 27, 2012, as to DC Comics’ ownership of rights to the Batmobile Vehicles via these third-party registrations. SUF at ¶ 17. However, at no time did Defendant ever propound a document request for copyright registration certificates beyond those items identified in Exhibit A to the First Amended Complaint. GD at ¶¶ 45, 47. Once these archived, third-party registrations were received from the U.S. Copyright Office, DC Comics promptly forwarded them to Defendant in anticipation of the motions for summary judgment. *Id.*; SUF at ¶ 18.

1 Second, DC Comics fully complied with the disclosure requirements of Fed. R.
 2 Civ. P. 26. It timely identified all registrations and produced all relevant registration
 3 certificates within its possession, custody or control during discovery, including the
 4 contracts upon which it claims copyright interests in the Batmobile Vehicles
 5 (including agreements with third-parties relating to the 1966 *Batman* television series
 6 and 1989 *Batman* motion picture) well in advance of deadlines contemplated by the
 7 Federal Rules. SUF at ¶¶ 15, 18; see also Fed. R. Civ. P. 26(a)(3)(B) (“disclosures
 8 must be made at least 30 days before trial”). Rule 26 requires disclosure, not
 9 production, and disclosure of the copyright registrations of the 1960s television series
 10 and motion picture registrations – public documents *equally* available to Defendant –
 11 was indisputably made here.

12 Defendant, however, argues that Rule 26 disclosure is not enough, asserting that
 13 all copyrights on which DC Comics relies had to be listed in the Complaint.
 14 Defendant ignores the fact that the 1966 series and the 1989 movie were specifically
 15 addressed in the **body** of the Complaint, GD at ¶¶ 1 & 3, improperly focusing his
 16 argument entirely on one exhibit. Further, there is no requirement for the particularity
 17 Defendant seeks.¹³ Rule 8(a)(2) sets a liberal pleading standard based on notice of the
 18 claims. Conley v. Gibson, 355 U.S. 41, 47 (1957). The rule requires only a “‘short
 19 and plain statement of the claim showing that the pleader is entitled to relief,’ in order
 20 to ‘give the [opposing party] fair notice of what the ... claim is and the grounds upon
 21 which it rests.’” Bell Atl. Corp. v. Twombly, 550 U.S. 544, 555 (2007), quoting
 22 Conley, 355 U.S. at 47. Moreover, Defendant did not pursue and thus waived any

23
 24 ¹³Even were an amendment required, Fed. R. Civ. P. 15(a) provides that “leave [to amend the
 25 pleadings] shall be freely given when justice so requires” and lies “within the sound discretion of the
 26 trial court.” DCD Programs, Ltd. V. Leighton, 833 F.2d 183, 185 (9th Cir. 1987) (citation omitted);
 27 Martinez v. Newport Beach City, 125 F.3d 777, 785 (9th Cir. 1997) (“leave to amend should be
 28 granted unless amendment would cause undue prejudice to the opposing party, is sought in bad faith,
 is futile, or creates undue delay.”). In making this determination, “a court must be guided by the
 underlying purpose of Rule 15, -- to facilitate decision on the merits rather than on the pleadings or
 technicalities.” DCD Programs, 833 F.2d at 186. “In adhering to Rule 15’s policy favoring
 amendment, the court should apply that policy with ‘extreme liberality.’” Id.; Imax Corporation, et
al v. In-Three, Inc., 2005 U.S. Dist. Court 24198, at *3-4 (C.D. Cal. July 8, 2005).

1 argument for a more definite statement. Fed. R. Civ. P. 12(e). The alleged pleading
 2 defects have never prevented Defendant from understanding what the case is about or
 3 what discovery was required. To bring these alleged issues before the Court now on
 4 summary judgment, after discovery has closed, is procedurally incorrect and contrary
 5 to the relevant case law.¹⁴

6 Third, DC Comics was not in possession of the physical certificates until the
 7 end of discovery. As noted above, although DC Comics owns copyright interests in
 8 the works covered by those registrations, it was not the copyright registrant and
 9 therefore did not have copies of the actual registrations until they were retrieved from
 10 the U.S. Copyright Office archive. As soon as DC Comics received the certificates, it
 11 produced them to Defendant. SUF at ¶ 18; GD at ¶¶ 45, 47.

12 Fourth, Defendant can point to no prejudice whatsoever, precisely because there
 13 is none. Defendant has been on notice from the beginning of this lawsuit that DC
 14 Comics claimed rights in the depiction of the Batmobile Vehicles from the 1960s
 15 *Batman* television series and motion picture. SUF at ¶ 15. The fact that he was well
 16 aware of these registrations is not in dispute, as Defendant himself produced and
 17 requested (in December 2011) judicial notice of some of the same registrations he
 18 now seeks to exclude. SUF at ¶¶ 13, 16. Moreover, early in discovery, DC Comics
 19 produced all of the underlying agreements within its possession, custody or control
 20 concerning the 1960s *Batman* series and motion picture, through which DC Comics
 21 reserved its copyright interests. See SUF at ¶¶ 15, 18. Although it did not possess
 22 copies of certain copyright registrations, DC Comics timely identified the copyright

23
 24 ¹⁴ Defendant's non-binding, and in some cases inappropriate for citation, authority has no bearing on
 25 the case at hand. Gee v. CBS, Inc., 471 F. Supp. 600, 643 (E.D. Pa. 1979) did not refer to any
 26 specific copyrights and failed to mention any specific act of infringement at all. Plunket v. Estate of
 27 Dame Jean Conan Doyle, 2011 WL 175252, 2001 U.S. Dist LEXIS 2001, at *5 (S.D.N.Y. Feb. 22,
 28 2001) concerned a motion to dismiss where the plaintiff made no allegation of any copyright
 ownership interest. Bespaq Corp. v. Haoshen Trading Co., 2005 WL 14841, 2004 U.S. Dist. LEXIS
 21338 (N.D. Cal. 2005) is an unreported decision having nothing to do with Fed. R. Civ. P. 8. Four
Navy Seals & Jane Doe v. Assoc. Press, 413 F. Supp. 2d 1136, 1148 (S.D. Cal. 2005) advises
 Defendant that he should have moved for a more definite statement if he could not adequately
 determine the copyrights at issue in DC Comics' First Amended Complaint.

1 registration numbers for these works, based on information on the U.S. Copyright
2 Office's website, a website equally available to Defendant. Id. at ¶ 18. Finally, in
3 anticipation of the motions for summary judgment, DC Comics ordered the 1966
4 television series certificates from the U.S. Copyright Office on an expedited basis and
5 produced them as soon as they were received. Id. at ¶¶ 15, 18; GD at ¶ 10.

6 Defendants attempt to claim he was misled as to the copyright interests being
7 asserted by the testimony of DC Comics' witness and statements of DC Comics'
8 counsel similarly fails. As to DC Comics' witness, he clearly testified at deposition
9 that DC Comics' claims were as "set forth in the pleadings." GD at ¶ 7. The First
10 Amended Complaint (as well as the original Complaint) identified the 1966 television
11 series and the 1989 motion picture, among others, as works in which the Batmobile
12 Vehicles has appeared. GD at ¶¶ 1, 3. It then identified the "DC Comics Copyrighted
13 Designs" as "the Batman literary works, TV series, and motion pictures, including the
14 Batman Characters, the Batmobile Vehicles, and the 1966 Batmobile, and other DC
15 Comics' copyrighted works, and of works related thereto." Id. A "representative,"
16 not exhaustive, list of copyright registrations was attached. Id. Thus, the pleadings
17 adequately address the copyright registrations with which Defendant now takes issue.

18 As to DC Comics' counsel, he made clear that the list of copyrights attached to
19 the pleading was merely "illustrative of numerous Batman registrations." When
20 defense counsel proceeded down a path that appeared to be inconsistent with the
21 discussion concerning Exhibit A to the First Amended Complaint, DC Comics'
22 counsel clarified that the witness could only testify as to facts as to what was produced
23 from that list, which were the registrations in which DC Comics is the registered
24 copyright claimant (excluding registrations of licensors, affiliated companies, etc.).
25 GD at ¶¶ 8-9. Moreover, DC Comics made clear that there were registrations at issue
26 outside of the complaint as set forth in discovery responses. GD at ¶¶ 7-9. At no time
27 was Defendant's counsel misled as to the copyright interests being relied upon.
28

1 In sum, Defendant has been on notice from the start of (and repeatedly
 2 throughout) litigation as to DC Comics' rights in the Batmobile Vehicles as they
 3 appeared in the 1966 television series and the 1989 motion picture. Defendant has in
 4 no way been prejudiced in the production of public record documents at all times
 5 equally available to Defendant. "[E]xclusion of critical evidence is an extreme
 6 sanction." Meyers v. Pennypack Woods Home Ownership Ass'n, 559 F.2d 894, 905
 7 (3d Cir. 1977). Thus, the facts of this case do not remotely support the exclusion of
 8 the copyright registrations.

9 **IV. Defendant's Admissions Require a Finding for DC Comics on its**
 10 **Trademark Claims.**

11 DC Comics has established infringement of both its registered trademarks,
 12 pursuant to 15 U.S.C. § 32, and its unregistered trademarks, pursuant to 15 U.S.C. §
 13 43(a). Defendant does not dispute DC Comics' ownership of the trademarks, focusing
 14 exclusively and erroneously on a purported lack of *actual* confusion. However, this is
 15 but one factor in determining whether there is a likelihood of confusion, the applicable
 16 standard for trademark infringement, AMF v. Sleekcraft, 599 F.2d 341, 348-49 (9th
 17 Cir. 1979), and in fact, Defendant advances no evidentiary support for this improperly
 18 narrow view nor his affirmative defense of laches. Thus, there is no controverted fact
 19 that judgment must be entered against Defendant as to DC Comics' trademark claims.

20 **A. Defendant Misstates and Misapplies the Requirement of "Likelihood of**
 21 **Confusion" Which Is Presumed by Binding Authority in Cases**
 22 **Involving "Replicas."**

23 In the Ninth Circuit, a presumption of confusion exists when dealing with
 24 counterfeit or "replicas." Brookfield Communs. v. W. Coast Entm't Corp., 174 F.3d
 25 1036, 1056 (9th Cir. 1999) ("In light of the virtual identity of marks, if they were used
 26 with identical products or services likelihood of confusion would follow as a matter of
 27 course."); see Lindy Pen Co. v. Bic Pen Corp., 796 F.2d 254, 256-57 (9th Cir. 1986)
 28 (reversing a district court's finding of no likelihood of confusion even though the six

1 other likelihood of confusion factors all weighed against a finding of likelihood of
 2 confusion); Phillip Morris USA Inc. v. Shalabi, 352 F. Supp. 2d 1067, 1073 (C.D. Cal.
 3 2004) citing Phillip Morris USA Inc. v. Felizardo, 2004 U.S. Dist. LEXIS 11154, at
 4 *18 (S.D.N.Y. June 18, 2004) ("in cases involving counterfeit marks, it is
 5 unnecessary to perform the step-by-step examination . . . because counterfeit marks
 6 are inherently confusing."). Defendant admits to producing replicas of the Batmobile
 7 Vehicles which bear counterfeit copies of DC Comics' trademarks in numerous
 8 places. Thus, likelihood of confusion is presumed.

9 Moreover, Defendant's evidence that some individual purchasers (and not all)
 10 now state that they were not confused concerning Defendant's relationship with DC
 11 Comics is inaccurate and insufficient to demonstrate that there is no likelihood of
 12 confusion arising from Defendant's admitted use of DC Comics' trademarks.¹⁵ As a
 13 matter of law, the courts do not limit "likelihood of confusion" evidence to direct
 14 purchasers: "The law in the Ninth Circuit is clear that "post-purchase confusion," *i.e.*,
 15 confusion on the part of someone other than the purchaser who, for example, simply
 16 sees the item after it has been purchased, can establish the required likelihood of
 17 confusion under the Lanham Act." Karl Storz Endoscopy-Am., Inc. v. Surgical
 18 Techs., Inc., 285 F.3d 848, 854 (9th Cir. 2002) citing Academy of Motion Picture Arts
 19 & Sciences v. Creative House Promotions, Inc., 944 F.2d 1446, 1456 (9th Cir. 1991);
 20 Levi Strauss & Co. v. Blue Bell, Inc., 632 F.2d 817, 822 (9th Cir. 1980); see also
 21 Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand Mgmt., 613 F.3d 1025, 1032
 22 (9th Cir. 2010). Endorsing the rationale that the confusion of non-purchasers
 23 observing the infringing item is "no less injurious to the trademark owner's reputation
 24 than confusion on the part of the purchaser at the time of sale." Karl Storz
 25 Endoscopy-Am., 285 F.3d at 854 citing Payless Shoesource, Inc. v. Reebok Int'l Ltd.,

26
 27 ¹⁵ Defendant Towle testified as to more sales than the five customers who supplied declarations in
 28 support of his Motion. Towle Depo. at pp. 30:7-31:2 (1989 Batmobile replica: 4 functioning, 2 non-
 functioning, 4 kits), 13:12-16, 25:4-6 (1966 Batmobile replica: "more than 15, less than 25"
 replicas, two, maybe three kits).

1 998 F.2d 985, 989-90 (Fed. Cir. 1993). This confusion is exacerbated where, as here,
 2 Defendant exhibited and showcased the infringing replicas thus assuring a wider
 3 audience for post-purchase confusion. Towle Depo. at 29:2-7 (1989 Batmobile
 4 replica displayed at auction), 56:8-16 (1966 Batmobile replica displayed at auction).
 5 Defendant's submission of declarations from a few past purchasers is, thus, irrelevant.

6 What is more, Defendant startlingly admits that most of his customers asked if
 7 he was licensed (albeit by DC Comics' affiliated company Warner Bros). SUF at ¶
 8 23. This admission *establishes as a matter of law actual confusion*. Likelihood of
 9 confusion is not limited to "when consumers are confused as to the source of a
 10 product they actually purchase." Brookfield, 174 F.3d at 1057. "Although dispelled
 11 before an actual sale occurs, initial interest confusion impermissibly capitalizes on the
 12 goodwill associated with a mark and is therefore actionable trademark infringement."
 13 Playboy Enters. v. Netscape Communs. Corp., 354 F.3d 1020, 1025 (9th Cir. 2004).
 14 The undisputed record thus requires a finding of infringement.

15 Moreover, even were Towle to submit evidence from each and every one of his
 16 purchasers, the evidence would be at best probative of one factor in determining
 17 likelihood of confusion. As set forth in Sleekcraft, evidence of actual confusion (and
 18 not evidence of lack of confusion by individual consumers) is weighed – along with
 19 six other factors – in determining whether a likelihood of confusion exists. As set
 20 forth by DC Comics in support of its motion for summary judgment, all of these other
 21 factors weigh in favor of a finding of likelihood of confusion, and Defendant has
 22 adduced absolutely no evidence to contradict that showing. Motion, pp. 23-25.

23 Defendant's motion for summary judgment as to DC Comics' trademark claim
 24 should be summarily denied.

25 **B. Registration in the Same Class of Goods Is Not Required for**
 26 **Trademark Infringement.**

27 Defendant does not dispute his unauthorized use of DC Comics' many
 28 trademarks. Defendant instead attempts to argue that DC Comics is barred from

1 recovery because the BATMOBILE® trademark for “Automobiles” or for “Custom
2 Manufacturing in the Field of Automobiles” was not filed until approximately 8
3 months before the lawsuit. Motion, p. 24. However, as Defendant notes, DC Comics
4 has owned trademarks for BATMOBILE® for “toys” and “toy vehicles” since 1979
5 and 1981, respectively, which covers the infringing products and use at issue.¹⁶

6 “A valid ownership interest in a mark (for any product class) is sufficient,
7 although not necessary, to provide standing for infringement of that mark.” Halicki
8 Films, 547 F.3d at 1225 (9th Cir. 2008) citing 15 U.S.C. §§ 1114(1), 1125 (a); see also
9 Lahoti v. VeriCheck, Inc., 586 F. 3d 1190, 1196-97 (9th Cir. 2009) (citations omitted)
10 (trademark registration not a prerequisite to a claim of trademark infringement). A
11 senior user of a trademark can enforce its rights against any junior users using
12 confusingly similar marks in a similar industry or within the senior user’s natural zone
13 of expansion. See New West Corp. v. NYM Co. of California, Inc., 595 F.2d 1194,
14 1200-01 (9th Cir. 1979). In fact, courts have extended trademark protection to even
15 less-famous (in some cases, completely unregistered) comic book “ingredients.” DC
16 Comics v. Kryptonite Corp., 336 F. Supp. 2d 324, 332 (S.D.N.Y. 2004)
17 (“KRYPTONITE” protectable under the Lanham Act “as an ingredient of an
18 entertainment property”); DC Comics v. Reel Fantasy, 696 F.2d 24, 25 (2d Cir. 1982)
19 (“BATCAVE” protectable); DC Comics, Inc. v. Powers, 465 F. Supp. 843 (S.D.N.Y.
20 1978) (“DAILY PLANET” protectable). Defendant also admits his replicas are based
21 on DC Comics’ works. SUF at ¶¶ 10-12 14; GD at ¶¶ 61-72, 76-79; SS at ¶¶ 45-50.
22 There is no doubt that Defendant intended to pass off his goods as those of DC
23 Comics. Additionally, BATMOBILE® for “Custom manufacturing in the field of
24 automobiles” is now a registered mark as of November 20, 2012, with registration
25 number 4,246,497, such that Defendant’s argument is also moot.

26
27
28 ¹⁶ Defendant offered on eBay, “build[s]” of a 1966 replica Batmobile with the purchase of a toy.
Towle Depo. at pp. 59:20-60:5.

1 In a very similar case, Warner Bros. secured a judgment of trademark
 2 infringement against a manufacturer of replica toys of the “General Lee” automobile,
 3 which appeared in the “Dukes of Hazzard” television series, even though Warner
 4 Bros. was not a manufacturer of toy cars. Warner Bros., Inc. v. Gay Toys, Inc., 724
 5 F.2d 327, 333 (2d Cir. 1983); see also Processed Plastic Co. v. Warner Comms., Inc.,
 6 675 F.2d 852, 856 (7th Cir. 1982) (same). The crux of the analysis, consistent with
 7 one of the fundamentals of trademark law, was consumer association and in Gay
 8 Toys, while there was some proof of association of the “General Lee” with the
 9 television series, here, Defendant’s customers and even Defendant himself admits the
 10 association between his replicas (and all replicas) with the television series and motion
 11 pictures using DC Comics’ original BATMAN elements. 724 F.2d at 333; SUF at ¶¶
 12 10-12 14; GD at ¶¶ 61-72, 76-79; SS at ¶¶ 45-50. Thus, Defendant should be found
 13 liable for trademark infringement.



14 **C. The Record Fails to Support Defendant’s Burden on the Six Factor Test**
 15 **Applicable to the Affirmative Defense of Laches.**

16 Defendant cannot meet his burden to establish a defense of laches as a matter of
 17 law. Laches normally do not apply when an action is filed within the applicable
 18 statute of limitations, and Defendant’s defense also fails because he does not apply the
 19 correct test or adduce evidence supporting even any one of the required elements.

20 First, trademark “infringement is a continuing wrong.” Jarrow Formulas, Inc.
 21 v. Nutrition Now, Inc., 304 F.3d 829, 837 (9th Cir. 2002) quoting 4 J. Thomas
 22 McCarthy, McCarthy on Trademarks and Unfair Competition § 31.33 (4th ed. 2001).
 23 A “strong presumption” that laches is inapplicable applies when a plaintiff files suit
 24 within the analogous statute of limitations period. Jarrow Formulas, 304 F.3d at 835-
 25 836 citing Shouse v. Pierce County, 559 F.2d 1142, 1147 (9th Cir. 1977) (“It is
 26 extremely rare for laches to be effectively invoked when a plaintiff has filed his action
 27 before limitations in an analogous action at law has run.”). Further, “[t]he Lanham
 28

Act contains no explicit statute of limitations.” Jarrow Formulas, 304 F.3d at 836.¹⁷ DC Comics filed its Complaint on May 6, 2011. Defendant admits to selling his kits and replicas as late as 2010, just months prior to DC Comics’ filing. SUF at ¶ 24. Defendant also continued marketing his goods up to 2011 on various message boards. SUF at ¶ 19. Moreover, the doctrine of laches does not apply in cases of willful infringement. Evergreen Safety Council v. RSA Network Inc., 2012 U.S. App. LEXIS 21593, at *12 (9th Cir. Oct. 17, 2012). Here, there is no question that Defendant is intentionally seeking to trade off of the goodwill associated with DC Comics’ famous Batman-related trademarks. Therefore, a strong presumption against laches applies, even if available, that Defendant is unable to overcome.

Additionally, the Ninth Circuit has set forth six factors “for determining whether laches bars a claim for either damages or injunctive relief in an action for trademark infringement.” Grupo Gigante S.A. de C.V. v. Dallo & Co., 391 F.3d 1088, 1102 (9th Cir. 2004). They are “(1) strength and value of trademark rights asserted; (2) plaintiff’s diligence in enforcing mark; (3) harm to senior user if relief denied; (4) good faith ignorance by junior user; (5) competition between senior and junior users; and (6) extent of harm suffered by junior user because of senior user’s delay.” Id., citing E-Systems Inc. v. Monitek, Inc., 720 F.2d 604, 607 (9th Cir. 1983). All factors support a rejection of the defense.

The first, third, fourth and fifth factors, strongly support DC Comics. Defendant agrees that the Batmobiles are famous. SUF at ¶ 1. DC Comics’ trademarks, including, but not limited to, BATMOBILE®, the BAT Emblem, the BAT REP II, BATMAN®, and various stylized variations of the BAT symbol, specifically including  and  are exceptionally strong. SS at ¶¶ 35-38. Defendant admits his products are replicas of creations depicted in television

¹⁷ Defendant declares that the statute of limitations for trademark infringement actions is three years based upon § 338 of the California Code of Civil Procedure. However, the referenced section does not reference trademark infringement (let alone the federal cause of action asserted by DC Comics). However, even were he correct, the Complaint was filed within three years of a number of his admitted sales and activities. Motion, p. 22:11-13 citing California Code of Civil Procedure § 338.

1 series and motion pictures based on DC Comics' original characters and story. SUF at
 2 ¶¶ 10-12 14; GD at ¶¶ 61-72, 76-79; SS at ¶¶ 45-50. The strength and enormous value
 3 of the Batman franchise and associated trademarks, including those at issue here, can
 4 not be disputed as reflected by significant box office successes, and extensive
 5 licensing and merchandising by DC Comics. SS at ¶¶ 3-4, 13, 24-27, 34-42; SUF at
 6 ¶¶ 2, 6, 20. DC Comics has also licensed other individuals, not limited to Fiberglass
 7 Freaks, the right to manufacture and customize full-size automobiles into the
 8 Batmobile Vehicles, featuring the DC Comics Trademarks, which directly compete
 9 with Defendant's unauthorized replicas. SS at ¶¶ 35-39; SUF at ¶¶ 6, 20.

10 The second factor also favors DC Comics as it has diligently enforced its marks
 11 in the Batman series and regarding unauthorized Batmobiles specifically. DC Comics
 12 has obtained trademark registrations and has engaged in ongoing efforts to enforce its
 13 rights against other manufacturers of infringing Batmobiles on a worldwide basis.
 14 SUF at ¶ 21; GD at ¶ 89. Prior to the Complaint being filed, Defendant's eBay
 15 listings were also the subject of take down requests. GD at ¶ 83. DC Comics was in
 16 no way sitting on its rights and any delay in filing suit was reasonable.

17 While any rights owner would choose to pursue every infringer at once, that is
 18 not realistic. In the Ninth Circuit, "delay has been held permissible, among other
 19 reasons, when it is . . . used to evaluate and prepare a complicated claim,' and when its
 20 purpose is to determine whether the scope of proposed infringement will justify the
 21 cost of litigation[.]'" See Danjaq LLC v. Sony Corp., 263 F.3d 942, 954 (9th Cir.
 22 (2001) quoting Lotus Dev. Corp. v. Borland Int'l. Inc., 831 F. Supp. 202, 219 (D.
 23 Mass. 1993), rev'd on other grounds, 49 F.3d 807 (1st Cir. 1995), aff'd, 516 U.S. 233
 24 (1996). DC Comics engaged in reasonable, time consuming steps to curb the
 25 infringement of its rights, including the infringement by Defendant.

26 As to the sixth factor, Defendant is selling replicas of DC Comics' intellectual
 27 property. While Defendant claims he has turned down a number of offers from
 28 potential buyers, GD at ¶ 85, that is inadmissible hearsay and unsupported by any

1 other evidence. Defendant has not pointed to any admissible evidence demonstrating
2 that he has suffered prejudice as a result of the delay in filing suit. See Evergreen
3 Safety Council, 2012 U.S. App. LEXIS 21593, at **8-9 (prejudice required for laches
4 defense); Hokto Kinoko Co. v. Concord Farms, Inc., 810 F. Supp. 2d 1013, 1036
5 (C.D. Cal. 2011) (laches defense requires specific facts showing prejudice).
6 Defendant cannot suffer prejudice by simply continuing to make unauthorized replicas
7 of products he knew to be owned by a third-party.

8 Defendant's assertions that DC Comics had actual knowledge of Defendant's
9 activities as early as 2005 and possibly 2003 have no evidentiary support. Motion, at
10 p. 22:14-17; GD at ¶¶ 82, 88. None of the alleged communications demonstrate
11 knowledge by DC Comics of Defendant's building and selling replica Batmobiles, the
12 gravamen of this action. GD at ¶¶ 82, 88.

13 The 2003 claim is without merit as Defendant made misleading statements
14 about his activities when he said that he was not going to do "anything" with the
15 Batmobile shell in light of a design patent. GD at ¶ 82. The alleged incident was a
16 "very short call" not lasting more than "three minutes." Id. Defendant also testified
17 that in a handful of alleged conversations with a "Julian Montoya," he never discussed
18 his replicas of the Batmobile Vehicles instead seeking details about the deal being
19 worked out with a third-party as to licensed replicas of the Batmobile Vehicles. GD at
20 ¶ 88. Accordingly, Defendant has not and cannot meet his burden to establish DC
21 Comics' knowledge of his infringement until immediately prior to the litigation.

22 The 2005 claim is similarly misplaced. DC Comics' witness did not testify that
23 no acts were taken against Defendant prior to 2006, he testified that he did not recall.
24 GD at ¶ 83. Significantly, Defendant has introduced no such correspondence.
25 Moreover, Mr. Kogan did not identify what alleged "activity" was known and,
26 specifically, whether it included the construction, sale or marketing of replicas or kits
27 of the Batmobile Vehicles. GD at ¶¶ 83, 88. In fact, upon further internal review, it
28 was determined that Defendant was brought to DC Comics' attention in 2006 due to

1 Defendant's manufacture of a Batboat, **not** the Batmobile Vehicles at issue here. GD
 2 at ¶ 88. Additionally, Defendant admits that several of his eBay auctions for replicas
 3 of the Batmobile Vehicles were taken down as infringing by DC Comics over the
 4 years, evidencing the fact that DC Comics did not sit on its rights. *Id.* at ¶ 83.

5 An adjudication barring Defendant's laches defense is in line with existing
 6 controlling authority finding laches where the delay was "lengthy" on the order of
 7 numerous years. *Danjaq*, 263 F.3d at 953 (finding delay of 19-36 years as sufficient
 8 for laches); *Jarrow Formulas*, 304 F.3d at 839 (seven year delay); *E-Systems*, 720
 9 F.2d at 607 (allegedly infringing mark had been used for eight years where the
 10 claimant had known of the infringing use for at least six years). DC Comics did not
 11 delay as it was engaged in the enforcement of its rights, including investigating and
 12 preparing this case, which can not be considered unreasonable.

13 Finally, even if Defendant were to succeed on establishing a laches defense, at
 14 most this would simply preclude damages for conduct occurring prior to the statute of
 15 limitation. Damages for later infringement as well as permanent injunctive relief
 16 would not be barred. *See Danjaq*, 263 F.3d at 959-60; *Hampton v. Paramount*
 17 *Pictures Corp.*, 279 F.2d 100, 105 (9th Cir. 1960); 3 Melville B. Nimmer & David
 18 Nimmer, *Nimmer on Copyright* § 12.06, at 12-126 (2000).

19 CONCLUSION

20 For all of the foregoing reasons, DC Comics respectfully requests Defendant's
 21 Motion be denied in its entirety.

22
 23
 24 DATED: January 9, 2013

J. Andrew Coombs, A Professional Corp.

25 By: /s/ J. Andrew Coombs
 26 J. Andrew Coombs
 27 Nicole L. Drey
 28 Attorneys for Plaintiff DC Comics